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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/041,994	03/13/98	CHEN J	UMM026

LAHIVE & COCKFIELD  
28 STATE STREET  
BOSTON MA 02109

HM12/0623

EXAMINER
TUNG, F

ART UNIT	PAPER NUMBER
1652	9

DATE MAILED: 06/23/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/041,994**

Applicant(s)  
**Chen et al.**

Examiner  
**Peter Tung**

Group Art Unit  
**1652**



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-41 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-41 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-18, drawn to DNA encoding RAC3 protein, vectors, transformed host cells and a method of producing RAC3 protein, classified in class 435, subclass 69.1.
  - II. Claims 19 and 20, drawn to a transgenic animal, classified in class 800, subclass 8.
  - III. Claims 21-30 and 34, drawn to RAC3 protein, classified in class 530, subclass 350.
  - IV. Claims 31-33 and 35, drawn to RAC3 antibody, classified in class 530, subclass 387.9.
  - V. Claims 36 and 37, drawn to a method of using a RAC3 modulator, classified in class 530, subclass 300.
  - VI. Claims 38 and 39, drawn to a method for detecting the presence of RAC3 activity and a kit for detecting RAC3 activity, classified in class 435, subclass 4.
  - VII. Claim 40, drawn to a diagnostic assay for identifying a genetic alteration, classified in class 536, subclass 24.31.
  - VIII. Claim 41, drawn to a method of identifying a RAC3 modulator, classified in class 435, subclass 4.
2. The inventions are distinct, each from the other because of the following reasons:

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Each of Groups I, II, III, IV, VI and VII is directed to a separate and distinct invention. Group I is directed to DNA encoding RAC3 protein, vectors and transformed host cells, Group II is directed toward a transgenic animal, Group III is directed toward RAC3 protein, Group IV is directed toward RAC3 protein antibody, Group VI is directed toward a kit for detecting the presence of RAC3 activity and Group VII is directed toward a diagnostic kit for identifying a genetic alteration.

The products of Groups I, II, III, IV, VI and VII would be expected to have distinct morphological, functional, chemical and physical properties as indicated by their divergent classification, process of making and process of using. These products are capable of separate manufacture, use, or sale as claimed, and are patentably distinct.

3. Each of Groups I, V, VI and VIII is directed to a separate and distinct invention. Group I is directed to a method of making RAC3 protein, Group V is directed to a method of using a RAC3 modulator, Group VI is directed to a method of detecting RAC3 activity and Group VIII is directed to a method of identifying a RAC3 modulator. These methods are distinct both physically and functionally, require different process steps, reagents and parameters and produce different products.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Tung, Ph.D. whose telephone number is (703) 308-9436. The examiner can normally be reached on Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, Ph.D., can be reached on (703) 308-3804. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



PONNATHAPU ACHUTAMURTHY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600